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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,683	08/31/2006	Hyunsil Han	196034542	4626

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EXAMINER	
JAVANMARD, SAHAR	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of: :
Han et al. :
Serial No.: 10/575,683 : PETITION DECISION
Filed: August 31, 2008 :
Attorney Docket No.: **196034542** :

This is in response to the petition under 37 CFR § 1.181, filed June 23, 2010, requesting that the finality of the Office action of April 23, 2010 be withdrawn. The delay in responding to this petition is regretted but it has only just come to the attention of the Deciding Official.

BACKGROUND

The examiner mailed a non-final Office action on June 15, 2009 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1-48 were pending. The examiner withdrew claims 1-23, 25-31, 34-41 and 45-48 from consideration. The examiner rejected claims 24 and 44 under 35 USC 103 (a) as being unpatentable over Yamamoto as evidenced by the Medilexicon medical dictionary in view of Mitchell. Claims 32, 33, 42 and 43 were objected to.

In reply to the non-final Office action of 15, 2009, applicants filed a response on December 15, 2009. The response submitted by applicants included arguments traversing the rejections made in the non-final Office action.

On April 23, 2010, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1-48 were still pending. The examiner again rejected claims 24 and 44 under 35 USC 103 (a) as being unpatentable over Yamamoto as evidenced by the Medilexicon medical dictionary in view of Mitchell. Claims 32, 33, 34-41 and 42-43 were objected to.

In response thereto, applicants filed this petition on June 23, 2010, requesting that the finality of the Office action of April 23, 2010 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on June 23, 2010, applicants request that the finality of the Office action of April 23, 2010 be withdrawn. Applicants argue " The MPEP § 706.02 states (emphasis added): When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones,* 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy & the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, *a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection."* Applicants further argue " It is clear that the June 15, 2009, non-final office action did not comply with the provisions of MPEP § 706.02. That action only provided applicants with a copy of Yamamoto which was entirely in Japanese except for the English language abstract. However, it is apparent from the June 15, 2009, non-final office action that the examiner was relying on more than just the English language abstract of this reference. In particular, in referring to substituents of a chemical structure, which are nowhere to be found in the abstract of Yamamoto, it is clear that the examiner was referring to either the Japanese text of this reference and/or an English language translation of it. However, by not providing such a translation, the June 15, 2009, office action not only failed to comply with MPEP § 706.02, but deprived applicants of an opportunity to fully understand Yamamoto and respond to that office action."

Applicants' arguments are well taken and persuasive that the examiner relied on a full translation at the time of the final Office action which amounts to a new reference being applied at the time of final rejection. Consequently, applicants have not been provided a fair opportunity to carefully consider and respond to this complete reference. Also, MPEP § 706.07 recites:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Thus, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection based on a translated document that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, it is decided that Applicants' arguments are well-taken and found persuasive.

DECISION

The petition is **GRANTED.**

The Office action mailed April 23, 2010 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Director, Technology Center 1600